

As the Final Rejection is understood, it acknowledges that the reference, EPO 109060, does not disclose a propylene production process carried out employing a catalyst which has been pretreated by heating the catalyst in steam and de-aluminating the catalyst by treatment with a complexing agent. However, the claimed subject matter is given no weight on the grounds that these are product by process limitations which do not distinguish the catalyst employed over the catalyst disclosed in EP01091060. While not agreeing with the Examiner's analysis that these are product by process limitations or that the subject matter can be ignored in evaluating patentability of the process as set forth in claim 1, claim 1 and the claims dependent thereof have been cancelled by this amendment. As the case now stands, it contains only claims of 15-22, which do not involve subject matter which can be characterized as product by process limitations, but instead positively recites a method for the production of polypropylene from an olefinic feed stock of at least one C₄₊ olefin. The process as set forth in independent claim 15 involves the following:

the heating of the MFI silicate catalyst in steam,

de-aluminating the heated catalyst by treating the catalyst with a complexing agent for aluminum to remove aluminum from the catalyst framework and provide a catalyst of increased silicon/aluminum atomic ratio within the range of 180-1000,

and then contacting the pretreated catalyst with the olefinic feed stock to provide an effluent with a propylene yield of 30-50% based on the olefinic content of the feed stock.

Independent claim 21 calls for this process and further specifies that the steaming procedure reduces tetrahedral aluminum to form amorphous alumina followed by treatment with the complexing agent to remove amorphous alumina from the catalyst framework.

The fact that the claimed steps are carried out prior to contacting of the catalyst with the olefinic feed stock does not detract from the fact that these are process limitations in process claims. The Manual of Patent Examining Procedure, makes clear that a lack of patentability under 35 U.S.C. 102 or 35 U.S.C. 103 cannot be established by simply ignoring claim limitations. Thus, as stated in MPEP Section 2116.01:

All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. See MPEP § 2143.03. (emphasis original)

.....
Interpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction requires treating language in a process claim, which recites the making or using of a nonobvious product as a material limitation.

MPEP § 2143.03 states:

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Considering the mandate of the Manual of Patent Examining Procedure that all claim limitations must be considered and that lack of novelty or a *prima facie* case of obviousness can be established only when all of the limitations are taught by or obvious in view of the prior art, it becomes evident that claims 15 and 21 and the claims dependent thereon are neither anticipated by or obvious in view of EP 109060.

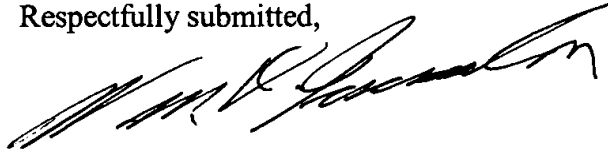
In regard to the decisions in *In re Marosi* and *In re Thorpe*, it is respectfully submitted that these decisions do not support the proposition that

process limitations in a process claim can be ignored. In fact, the *Marosi* decision clearly establishes the exact opposite. Thus, in *Marosi*, the court considered both process claims and product claims directed to a zeolite manufactured by the claimed process. The court, while affirming the rejection of the product by process claims, reversed the rejection of the process claims on the grounds that the prior art reference establishing a lack of patentability of the product by process claims did not render obvious the process itself. Hence, since claims 15-22 are process claims, embodying process limitations, it would appear that the decision cited by the Examiner support patentability of these claims.

It is evident that this amendment does not raise any new issues requiring further search and consideration. Accordingly, it is respectfully requested that this amendment be entered as a place in the application in condition for allowance or alternatively in a better form for appeal.

The commissioner is hereby authorized to charge any fee which may be due in connection with this amendment to deposit account no. 12-1781.

Respectfully submitted,



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Date: Oct 10, 2002

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